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10/04/04

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,823	10/23/2001	Francesco G. Salituro	VPI/99-01 CON US	1783

7590                    10/25/2004

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/035,823	SALITURO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas McKenzie, Ph.D.	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on amendments of 9/30/04.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,16-24 and 28-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1,16-24 and 28-39 is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This action is in response to amendments filed on 9/30/04. Applicant has amended claim 1. Applicant has canceled claims 4-15 and 25-27. Claims 28-39 are new. Claims 1 and 16-24 were previously rejected. There are twenty-two claims pending and under consideration. Claims 1, 16-24, 28, and 31-37 are compound claims. Claims 29 and 38 are composition claims. Claims 30 and 39 are use claims. The application concerns some 3-oximino indole compounds, compositions, and uses thereof.

*Response to Amendment*

2. Applicants' amendments of 12/22/03 contained two claims numbered 17. In the present action Applicants have correctly renumbered claims 17-26 to 18-27. The previous claim 24, discussed in point #4 of the previous office action is now claim 25 and in any case has been canceled.

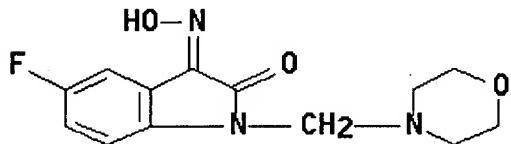
*Oath/Declaration*

3. The oath or declaration remains defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: Non-initialed and/or non-dated alterations have been made to Applicant Wilke's address. See 37 CFR 1.52(c).

Applicants' remarks concerning the difficulty of locating Applicant Wilke and their intent to file a Rule 47(a) petition are noted.

***Allowable Subject Matter***

4. Claims 1, 16-24, and 28-39 are allowed. The following is a statement of reasons for the indication of allowable subject matter: Applicants compounds are patentable over both Tran (Tap Chi Duoc Hoc (5)) and Tran (Tap Chi Duoc Hoc (12)). These two publications teach compounds including the one shown below. It fits the formula of claim 1 with R<sup>2</sup> = fluorine, R<sup>1</sup> = R<sup>3</sup> = R<sup>4</sup> = R<sup>5</sup> = hydrogen, Y = CH<sub>2</sub>-Q<sub>1</sub>, and Q<sub>1</sub> = the non-aromatic heterocycle morpholine. It has Registry Number 329376-63-8. However, both Tran (Tap Chi Duoc Hoc (5)) and Tran (Tap Chi Duoc Hoc (12)) are incompetent references because of Applicants' effective filing date of 4/21/00.



***Conclusion***

5. This application is in condition for allowance except for the following formal matters: the oath. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213. A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

6. Information regarding the status of an application should be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). Please direct general inquiries to the receptionist whose telephone number is (703) 308-1235.

7. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (571) 272-0670. The FAX number for amendments is (703) 872-9306. The PTO presently encourages all applicants to communicate by FAX. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, please contact Mukund Shah SPE of 1624 at (571)-272-0674.

  
Thomas C. McKenzie, Ph.D.  
Patent Examiner  
Art Unit 1624

TCMcK/me